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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 01/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/316,908

Applicant(s)

KISONO, MASAHIRO

Examiner

Joseph R. Pokrzywa

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/3/03 has been entered.

Response to Amendment

2. Applicant's amendment was received on 11/3/03, and has been entered and made of record. Currently, **claims 1-20** are pending.

Drawings

3. The drawings were received on 11/3/03. These drawings are acceptable.

Response to Arguments

4. Applicant's arguments filed 11/3/03 have been fully considered but they are not persuasive.

5. In response to applicant's arguments regarding the rejection of independent **claims 1, 6, and 12**, as being anticipated by Westwick *et al.* (U.S. Patent Number 5,828,836), cited in the Office action dated 8/6/03, whereby applicant argues on pages 13 and 14 that Westwick fails to

Art Unit: 2622

teach exchange of facsimile capability information between the host processor and the local terminals, as the host processor in the system of Westwick does not generate an image in accordance with the capabilities of the called terminal. Further, applicant argues that Westwick does not teach if the user profiles, information unit routing and billing information are used to generate facsimile image information which is acceptable to the called data terminal.

While the invention taught by Westwick differs from the invention defined in the current application, one can interpret Westwick as anticipating independent claims 1, 6 and 12, as they are currently worded. First, the examiner notes that the limitation argued by applicant that requires “generating facsimile image information which is acceptable to the called data terminal” is not found in the independent claims. Further, “exchanging” capability information is also not found. Claim 1 requires “collecting information sets of communication capabilities of a plurality of different data terminals on said local area network at an arbitrary time on said client data terminal”. Westwick can be seen as teaching the limitation of storing information sets of communication capabilities in column 2, lines 34 through 56, and column 4, lines 7 through 14, wherein users that are found in the profiles will have the communication capabilities of the system. Further, Westwick teaches that collecting the information sets on a client data terminal (host processor 12) of communication capabilities of a plurality of different data terminals (the users of terminals 18A-18N) on a local area network (network 16) at an arbitrary time (column 6, lines 16 through 23, whereby users of terminals 18A-18N can update information in their profiles at arbitrary times).

Continuing, the examiner notes that the claim does not specifically require “generating an image” in accordance with the capabilities. Rather, the claim requires generating “facsimile

Art Unit: 2622

image information". Westwick teaches of generating "facsimile image information", being a generated "Deliver Information Unit Control Message" or a "Process a Copy Information Unit Control Message", as read in column 8, lines 43 through 59, and column 9, lines 1 through 10. The examiner understands that this is not a facsimile image. However, one of ordinary skill in the art can recognize that these control messages taught by Westwick are "facsimile image information", since they contain **information** regarding a particular **facsimile image** that is to be delivered or copied. Thus, Westwick teaches of generating on the client data terminal (12), facsimile image information (being a "Deliver Information Unit Control Message") by reference to a stored information set of communication capabilities pertaining to the called data terminal (column 10, lines 3 through 15, wherein reference is made to the user profiles, which include setup options requested by the user).

6. Therefore, the rejection of **claim 1**, along with **claims 6 and 12**, as well as their corresponding dependent claims, which were cited in the Office action dated 3/27/03 under 35 U.S.C. 102(e), as being anticipated by Westwick *et al.*, is again maintained and repeated in this Office action.

7. In response to applicant's arguments regarding the rejection of **claims 1, 6, and 12**, cited as being anticipated by Suzuki (U.S. Patent Number 6,005,677), which state on pages 14 and 15 that Suzuki, similar to that of Westwick, discussed above, also fails to teach of exchanging capability information between the facsimile device and the called data terminal, as the facsimile device of Suzuki does not generate a facsimile image in accordance with the capabilities of the called terminal. The examiner notes that the claims, as currently worded, do not particularly

Art Unit: 2622

convey these limitations. Notably, **claim 1** requires “collecting information sets of communication capabilities of a plurality of different data terminals on said local area network at an arbitrary time on said client data terminal, ...generating on said client data terminal facsimile image information by reference to one of said stored information sets of communication capabilities pertaining to said called data terminal”. With reference to claim 1, as it is currently worded, Suzuki teaches of collecting information sets of communication capabilities of a plurality of different data terminals (column 4, lines 25 through 45, whereby the conversion table stores IP addresses of data terminals, whereby when a called data terminal has a IP address included in the table, referenced by a correlating called telephone number, the called data terminal will have an internet facsimile communication capability; thus the conversion table seen in Fig. 3 stores information sets of communication capabilities of destination terminals) on said local area network at an arbitrary time on said client data terminal (column 5, lines 4 through 13, whereby the conversion table is renewed and updated with IP address information during a facsimile pre-transmission protocol to a particular called terminal when the called terminal is initially called, therein being at an arbitrary time; with this, the facsimile device FA1 or FA2 will know if a particular called terminal will have internet facsimile communication capabilities in any subsequent calls made to that terminal by referring to the conversion table seen in Fig. 3).

Continuing, Suzuki teaches of generating on said client data terminal facsimile image information by reference to one of said stored information sets of communication capabilities pertaining to said called data terminal (column 4, line 31 through column 5, line 28, whereby the facsimile image information is generated into either a format for Internet facsimile communication or a format for standard facsimile communication over the GSTN, based on if a

Art Unit: 2622

specified called terminal includes an IP address in the conversion table, thereby having an internet communication capability).

8. Therefore, the rejection of independent **claim 1**, along with independent **claims 6 and 12**, as well as their corresponding dependent claims, which were cited in the Office action dated 8/6/03 under 35 U.S.C. 102(e), as being anticipated by Suzuki, is again maintained and repeated in this Office action. Further, for the same reasons discussed above, the rejection of dependent **claims 3, 4, 9, 10, 15, and 16**, cited in the Office action dated 8/6/03, as being unpatentable over Suzuki in view of Fite, Jr. *et al.* (U.S. Patent Number 5,517,324), is also maintained and repeated.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. **Claims 1, 2, 5, 6, 8, 11, 12, 14, and 17** are rejected under 35 U.S.C. 102(e) as being anticipated by Westwick *et al.* (U.S. Patent Number 5,828,836, cited in the Office action dated 8/6/03).

Regarding **claim 1**, Westwick discloses a method of transmitting an information transfer request from a client data terminal (host processor 12), which is coupled to a local area network (LAN 16), to a called data terminal (I/O devices 18A-18N, seen in Fig. 1) which is coupled to

Art Unit: 2622

the local area network and a public switched telephone network (PSTN 19), with the method comprising collecting information sets of communication capabilities of a plurality of different data terminals on the local area network at an arbitrary time on the client data terminal (column 4, lines 7 through 26), the different data terminals being coupled to the local area network and the public switched telephone network and including the called data terminal (see Fig. 1), storing the information sets of communication capabilities into a memory (on-line storage 24, column 4, lines 12 through 14), generating on the client data terminal facsimile image information by reference to one of the stored information sets of communication capabilities pertaining to the called data terminal (column 9, lines 1 through 67), creating on the client data terminal an information transfer request for requesting transmission of the facsimile image information to an arbitrary facsimile machine connected to the public telephone network (column 8, lines 43 through 59, and column 9, lines 1 through 10), sending the information transfer request from the client data terminal to a communications controller (controller 14A-14N, column 8, lines 50 through 59), and transmitting the information transfer request from the communications controller (controller 14A-14N) to the called data terminal through the local area network upon a completion of the sending step (column 8, lines 50 through 67).

Regarding *claim 2*, Westwick discloses the method discussed above in claim 1, and further teaches that the information transfer request includes a telephone number of the arbitrary facsimile machine, the facsimile image information to be transmitted, property information of the facsimile image information, and identification information identifying the called data terminal (column 3, lines 4 through 19).

Regarding **claim 5**, Westwick discloses the method discussed above in claim 1, and further teaches that the communications controller has a default condition in which the communications controller is normally conditioned to send the information transfer request to a specific data terminal from among the different data terminals in the memory (column 5, line 33 through column 6, line 23), and can be released from the default condition and be set to a different data terminal when the client data terminal specifies another called data terminal to send the information transfer request (column 6, lines 16 through 41).

Regarding **claim 6**, Westwick discloses a client data terminal (host processor 12), which is coupled to a local area network (LAN 16), comprising a first communications device that generates facsimile image information by reference to information of communication capabilities of a called data terminal to which the first communications device requests to send such facsimile image information (column 8, lines 43 through 67, and column 9, lines 27 through 64) and then performs a standard facsimile communications operation with respect to an information transfer request for requesting a transmission of the facsimile image information to an arbitrary facsimile machine connected to a public switched telephone network (PSTN 19, seen in Fig. 1, column 3, line 63 through column 4, line 26), the called data terminal being one of a plurality of different data terminals coupled to the local area network and the public switched telephone network (I/O devices 18B-18N, see Fig. 1), a memory (on-line storage 24, column 4, lines 12 through 14), and a second communications device (data director 20, column 4, lines 7 through 26, and column 9, lines 29 through 52) that performs at an arbitrary time the standard communications operation with at least one of the plurality of different data terminals to receive information sets of communication capabilities of the at least one of the plurality of different

Art Unit: 2622

data terminals and stores such information into the memory (column 2, lines 29 through 61, column 5, line 6 through column 6, line 41, and column 10, lines 15 through 51), that performs the standard facsimile communications operation with the first communications device to send from the memory one of the information sets of communication capabilities which pertain to the called data terminal (column 9, lines 1 through 10), and that performs the standard facsimile communications operation, using the information transfer request received from the first communications device (column 8, line 50 through column 9, line 10), with the called data terminal through the local area network after completing the standard facsimile communications operation with the first communications device (column 2, line 29 through column 3, line 19), the second communications device being operatively connected to the first communications device and to the plurality of different data terminals via the local area network (see Fig. 1).

Regarding *claim 8*, Westwick discloses the terminal discussed above in claim 6, and further teaches that the information transfer request includes a telephone number of the arbitrary facsimile machine, the facsimile image information to be transmitted, property information of the facsimile image information, and identification information identifying the called data terminal (column 3, lines 4 through 19).

Regarding *claim 11*, Westwick discloses the terminal discussed above in claim 6, and further teaches that the first communications device has a default condition, in which the first communications device is normally conditioned to send the information transfer request to a specific data terminal from among the different data terminals in the memory (column 5, line 33 through column 6, line 23), and can be released from the default condition and be set to a another

different data terminal when the first communications device specifies another called data terminal (column 6, lines 16 through 41).

Regarding *claim 12*, Westwick discloses a client data terminal (host processor 12), which is coupled to a local area network (LAN 16), comprising a first communications means for generating facsimile image information by reference to information of communication capabilities of a called data terminal to which the first communications device requests to send such facsimile image information (column 8, lines 43 through 67, and column 9, lines 27 through 64) and then performs a standard facsimile communications operation with respect to an information transfer request for requesting a transmission of the facsimile image information to an arbitrary facsimile machine connected to a public switched telephone network (PSTN 19, seen in Fig. 1, column 3, line 63 through column 4, line 26), the called data terminal being one of a plurality of different data terminals coupled to the local area network and the public switched telephone network (I/O devices 18B-18N, see Fig. 1), a memory means (on-line storage 24, column 4, lines 12 through 14), and a second communications means (data director 20, column 4, lines 7 through 26, and column 9, lines 29 through 52) for performing at an arbitrary time the standard communications operation with at least one of the plurality of different data terminals to receive information sets of communication capabilities of the at least one of the plurality of different data terminals and stores such information into the memory means (column 2, lines 29 through 61, column 5, line 6 through column 6, line 41, and column 10, lines 15 through 51), performing the standard facsimile communications operation with the first communications means to send from the memory means one of the information sets of communication capabilities which pertain to the called data terminal (column 9, lines 1 through 10), and

Art Unit: 2622

performing the standard facsimile communications operation, using the information transfer request received from the first communications means (column 8, line 50 through column 9, line 10), with the called data terminal through the local area network after completing the standard facsimile communications operation with the first communications means (column 2, line 29 through column 3, line 19), the second communications means being operatively connected to the first communications means and to the plurality of different data terminals via the local area network (see Fig. 1).

Regarding *claim 14*, Westwick discloses the terminal discussed above in claim 12, and further teaches that the information transfer request includes a telephone number of the arbitrary facsimile machine, the facsimile image information to be transmitted, property information of the facsimile image information, and identification information identifying the called data terminal (column 3, lines 4 through 19).

Regarding *claim 17*, Westwick discloses the terminal discussed above in claim 12, and further teaches that the first communications means has a default condition, in which the first communications means is normally conditioned to send the information transfer request to a specific data terminal from among the different data terminals in the memory means (column 5, line 33 through column 6, line 23), and can be released from the default condition and be set to a another different data terminal when the first communications means specifies another called data terminal (column 6, lines 16 through 41).

11. **Claims 1, 2, 6-8, 12-14, and 18-20** are rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki (U.S. Patent Number 6,005,677, cited in the Office action dated 8/6/03).

Regarding *claim 1*, Suzuki discloses a method of transmitting an information transfer request from a client data terminal (facsimile device FA1), which is coupled to a local area network (local area networks LN1 and LNk, column 2, line 40 through column 3, line 2, and column 6, line 57 through column 7, line 13), to a called data terminal (facsimile device FAk) which is coupled to the local area network and a public switched telephone network (see Fig. 7), with the method comprising collecting information sets of communication capabilities of a plurality of different data terminals on the local area network at an arbitrary time on the client data terminal (see Fig. 3, and column 2, line 41 through column 3, line 2, and column 4, lines 31 through 45), the different data terminals being coupled to the local area network and the public switched telephone network and including the called data terminal (see Figs. 1 and 7), storing the information sets of communication capabilities into a memory (column 3, line 66 through column 4, line 13), generating on the client data terminal facsimile image information by reference to one of the stored information sets of communication capabilities pertaining to the called data terminal (steps 301-307, column 4, lines 31 through 45, and column 7, lines 23 through 53), creating on the client data terminal an information transfer request for requesting transmission of the facsimile image information to an arbitrary facsimile machine connected to the public telephone network (steps 302-307, column 7, lines 24 through 43), sending the information transfer request from the client data terminal to a communications controller (step 308, column 6, line 57 through column 7, line 4, and column 7, lines 31 through 53, wherein the image information and data is transferred to facsimile device FAk seen in Fig. 7), and

Art Unit: 2622

transmitting the information transfer request from the communications controller to the called data terminal through the local area network upon a completion of the sending step (step 308, column 7, lines 5 through 13, and column 7, lines 43 through 63).

Regarding **claim 2**, Suzuki discloses the method discussed above in claim 1, and further teaches that the information transfer request includes a telephone number of the arbitrary facsimile machine, the facsimile image information to be transmitted, property information of the facsimile image information, and identification information identifying the called data terminal (column 6, lines 57 through 66, seen in Fig. 8).

Regarding **claim 6**, Suzuki discloses a client data terminal (facsimile device FA1), which is coupled to a local area network (local area networks LN1 and LNk, column 2, line 40 through column 3, line 2, and column 6, line 57 through column 7, line 13), comprising a first communications device (network controlling apparatus 10, column 3, lines 36 through 46) that generates facsimile image information by reference to information of communication capabilities of a called data terminal to which the first communications device requests to send such facsimile image information ("no" in steps 305 and 313, leading to the process JC, seen in Figs. 9 and 10) and then performs a standard facsimile communications operation with respect to an information transfer request for requesting a transmission of the facsimile image information to an arbitrary facsimile machine connected to a public switched telephone network (column 8, lines 4 through 64), the called data terminal being one of a plurality of different data terminals coupled to the local area network and the public switched telephone network (see Figs. 1 and 7), a memory (parameter memory 3, column 3, lines 11 through 22, and column 3, line 66 through column 4, line 13), and a second communications device (LAN communication controlling unit

Art Unit: 2622

11) that performs at an arbitrary time the standard communications operation with at least one of the plurality of different data terminals to receive information sets of communication capabilities of the at least one of the plurality of different data terminals and stores such information into the memory (steps 320 and 321, column 8, lines 44 through 52), that performs the standard facsimile communications operation with the first communications device to send from the memory one of the information sets of communication capabilities which pertain to the called data terminal (process JC, seen in Fig. 10), and that performs the standard facsimile communications operation, using the information transfer request received from the first communications device (steps 306-309, and 314-317, column 7, line 36 through column 8, line 29), with the called data terminal through the local area network after completing the standard facsimile communications operation with the first communications device (steps 306-309, and 314-317, column 7, line 36 through column 8, line 29, whereby these process steps occur at a subsequent time when a transmission is initiated to a destination telephone number now stored in the telephone number conversion table), the second communications device being operatively connected to the first communications device (see Fig. 2) and to the plurality of different data terminals via the local area network (see Figs. 1 and 7).

Regarding **claim 7**, Suzuki discloses the terminal discussed above in claim 6, and further teaches that the second communications device controls the standard facsimile communication operation with the first communications device to perform throughout a plurality of facsimile communications steps which are defined as phases A through to E in accordance with a Group 3 facsimile communications procedure (column 3, lines 36 through 42, and column 4, line 65

Art Unit: 2622

through column 5, line 13, and column 8, lines 31 through 64, wherein the phases A through E are inherently included in a Group 3 communication).

Regarding **claim 8**, Suzuki discloses the terminal discussed above in claim 6, and further teaches that the information transfer request includes a telephone number of the arbitrary facsimile machine, the facsimile image information to be transmitted, property information of the facsimile image information, and identification information identifying the called data terminal (column 6, lines 57 through 66, seen in Fig. 8).

Regarding **claim 12**, Suzuki discloses a client data terminal (facsimile device FA1), which is coupled to a local area network (local area networks LN1 and LN_k, column 2, line 40 through column 3, line 2, and column 6, line 57 through column 7, line 13), comprising a first communications means (network controlling apparatus 10, column 3, lines 36 through 46) for generating facsimile image information by reference to information of communication capabilities of a called data terminal to which the first communications device requests to send such facsimile image information ("no" in steps 305 and 313, leading to the process JC, seen in Figs. 9 and 10) and then performs a standard facsimile communications operation with respect to an information transfer request for requesting a transmission of the facsimile image information to an arbitrary facsimile machine connected to a public switched telephone network (column 8, lines 4 through 64), the called data terminal being one of a plurality of different data terminals coupled to the local area network and the public switched telephone network (see Figs. 1 and 7), a memory means (parameter memory 3, column 3, lines 11 through 22, and column 3, line 66 through column 4, line 13), and a second communications means (LAN communication controlling unit 11) for performing at an arbitrary time the standard communications operation

with at least one of the plurality of different data terminals to receive information sets of communication capabilities of the at least one of the plurality of different data terminals and stores such information into the memory means (steps 320 and 321, column 8, lines 44 through 52), performing the standard facsimile communications operation with the first communications means to send from the memory means one of the information sets of communication capabilities which pertain to the called data terminal (process JC, seen in Fig. 10), and performing the standard facsimile communications operation with the first communications means to receive the information transfer request, and performing the standard facsimile communications operation, using the information transfer request received from the first communications means (steps 306-309, and 314-317, column 7, line 36 through column 8, line 29), with the called data terminal through the local area network after completing the standard facsimile communications operation with the first communications means (steps 306-309, and 314-317, column 7, line 36 through column 8, line 29, whereby these process steps occur at a subsequent time when a transmission is initiated to a destination telephone number now stored in the telephone number conversion table), the second communications means being operatively connected to the first communications means (see Fig. 2) and to the plurality of different data terminals via the local area network (see Figs. 1 and 7).

Regarding *claim 13*, Suzuki discloses the terminal discussed above in claim 12, and further teaches that the second communications means controls the standard facsimile communication operation with the first communications means to perform throughout a plurality of facsimile communications steps which are defined as phases A through to E in accordance with a Group 3 facsimile communications procedure (column 3, lines 36 through 42, and column

4, line 65 through column 5, line 13, and column 8, lines 31 through 64, wherein the phases A through E are inherently included in a Group 3 communication).

Regarding *claim 14*, Suzuki discloses the terminal discussed above in claim 12, and further teaches that the information transfer request includes a telephone number of the arbitrary facsimile machine, the facsimile image information to be transmitted, property information of the facsimile image information, and identification information identifying the called data terminal (column 6, lines 57 through 66, seen in Fig. 8).

Regarding *claim 18*, Suzuki discloses the method discussed above in claim 1, and further teaches that the one of the information sets of communication capabilities pertaining to the called data terminal is used to generate the facsimile image information in a format acceptable to the called data terminal (column 4, line 31 through column 5, line 28, whereby the facsimile image information is generated into either a format for Internet communication or a format for communication over the GSTN, based on if a specified called terminal includes an IP address in the conversion table, thereby having an internet communication capability).

Regarding *claim 19*, Suzuki discloses the terminal discussed above in claim 6, and further teaches that the information of communication capabilities of the called data terminal is used to generate the facsimile image information in a format acceptable to the called data terminal (column 4, line 31 through column 5, line 28, whereby the facsimile image information is generated into either a format for Internet communication or a format for communication over the GSTN, based on if a specified called terminal includes an IP address in the conversion table, thereby having an internet communication capability).

Art Unit: 2622

Regarding **claim 20**, Suzuki discloses the terminal discussed above in claim 12, and further teaches that the information of communication capabilities of the called data terminal is used to generate the facsimile image information in a format acceptable to the called data terminal (column 4, line 31 through column 5, line 28, whereby the facsimile image information is generated into either a format for Internet communication or a format for communication over the GSTN, based on if a specified called terminal includes an IP address in the conversion table, thereby having an internet communication capability).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 3, 4, 9, 10, 15, and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (U.S. Patent Number 6,005,677, cited in the Office action dated 8/6/03) in view of Fite, Jr. *et al.* (U.S. Patent Number 5,517,324, cited in the Office action dated 8/6/03).

Regarding **claim 3**, Suzuki discloses the method discussed above in claim 2, and further teaches that the information sets of communication capabilities of the different data terminals collected in the collecting step includes information identifying at least a connection for specifying one of the registered different data terminals (column 3, line 66 through column 4, line 13, seen in Fig. 3, being the connection to the IP or e-mail address), and encoding/decoding functions (column 7, lines 40 through 53). However, Suzuki fails to teach if the information sets

of communication capabilities of the different data terminals collected in the collecting step also include an image resolution, and a recording sheet size. Fite discloses a method of transmitting an information transfer request from a client data terminal (fax machine 12, seen in Fig. 1, column 4, lines 26 through 49), which is coupled to a called data terminal (fax machines 24), with the method comprising the steps of collecting information sets of communication capabilities of a plurality of different data terminals at an arbitrary time on the client data terminal (column 5, line 3 through column 6, line 11), the different data terminals being coupled to a network and including the called data terminal (see Fig. 1), generating on the client data terminal facsimile image information by reference to one of the information sets of communication capabilities pertaining to the called data terminal (column 11, line 3 through column 12, line 51), and transmitting the information to the called data terminal (column 12, lines 1 through 44). Fite further teaches that the information sets of communication capabilities of the different data terminals collected in the collecting step includes information identifying at least a connection for specifying one of the registered different data terminals, an image resolution, a recording sheet size, encoding/decoding functions (column 7, line 21 through column 8, line 34). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Fite's teachings in the system of Suzuki. Suzuki's system would easily be modified to include Fite's teachings, therein conforming to standards being well-known throughout the art.

Regarding **claim 4**, Suzuki discloses the method discussed above in claim 2, but fails to specifically teach of judging whether the facsimile image information to be transmitted has been encoded using an encoding function which is lower grade than the encoding/decoding functions

of the stored information set, and converting the facsimile image information to be transmitted using the encoding/decoding functions registered in the memory during the storing step when a result of the judging step determines that the facsimile image information to be transmitted is lower grade. Fite discloses a method (discussed above with respect to claim 3), further teaching of the steps of judging whether the facsimile image information to be transmitted has been encoded using an encoding function which is lower grade than the encoding/decoding functions of the stored information set, and converting the facsimile image information to be transmitted using the encoding/decoding functions registered in the memory during the storing step when a result of the judging step determines that the facsimile image information to be transmitted is lower grade (column 7, lines 1 through 34, column 12, lines 32 through 44, and column 13, lines 20 through 34). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Fite's teachings in the system of Suzuki. Suzuki's system would easily be modified to include Fite's teachings, therein conforming to standards being well-known throughout the art.

Regarding **claim 9**, Suzuki discloses the terminal discussed above in claim 6, and further teaches that the information sets of communication capabilities of the different data terminals sent from the first communications device to the second communications device includes information identifying at least a connection for specifying one of the registered different data terminals (column 3, line 66 through column 4, line 13, seen in Fig. 3, being the connection to the IP or e-mail address), and encoding/decoding functions (column 7, lines 40 through 53). However, Suzuki fails to teach if the information sets of communication capabilities of the different data terminals also include an image resolution, and a recording sheet size. Fite

Art Unit: 2622

discloses a client data terminal (fax machine 12, seen in Fig. 1, column 4, lines 26 through 49), comprising a first communications device that generates facsimile image information by reference to information of communication capabilities of a called data terminal (fax machines 24) to which the first communications device requests to send such facsimile image information and then performs a standard facsimile communications operation with respect to an information transfer request for requesting a transmission of the facsimile image information to an arbitrary facsimile machine connected to a public switched telephone network (column 11, lines 11 through 67), the called data terminal being one of a plurality of different data terminals coupled to the public switched telephone network (see Fig. 1), and a second communications device that performs at an arbitrary time the standard communications operation with at least one of the plurality of different data terminals to receive information sets of communication capabilities of the at least one of the plurality of different data terminals (column 5, line 3 through column 6, line 11). Fite further teaches that the information sets of communication capabilities of the different data terminals includes information identifying at least a connection for specifying one of the registered different data terminals, an image resolution, a recording sheet size, encoding/decoding functions (column 7, line 21 through column 8, line 34). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Fite's teachings in the system of Suzuki. Suzuki's system would easily be modified to include Fite's teachings, therein conforming to standards being well-known throughout the art.

Regarding **claim 10**, Suzuki discloses the terminal discussed above in claim 6, but fails to specifically teach if the second communications device can convert the information transfer request sent from the first communications device, using the encoding/decoding functions

Art Unit: 2622

registered in the memory as the information of communication capabilities of the called data terminal, when an encoding function used by the first communications device for conversion of the information transfer request is lower grade than the registered encoding/decoding functions. Fite discloses a terminal (discussed above with respect to claim 9), further teaching that the second communications device can convert the information transfer request sent from the first communications device, using the encoding/decoding functions registered in the memory as the information of communication capabilities of the called data terminal, when an encoding function used by the first communications device for conversion of the information transfer request is lower grade than the registered encoding/decoding functions (column 7, lines 1 through 34, column 12, lines 32 through 44, and column 13, lines 20 through 34). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Fite's teachings in the system of Suzuki. Suzuki's system would easily be modified to include Fite's teachings, therein conforming to standards being well-known throughout the art.

Regarding *claim 15*, Suzuki discloses the terminal discussed above in claim 12, and further teaches that the information sets of communication capabilities of the different data terminals sent from the first communications means to the second communications means includes information identifying at least a connection for specifying one of the registered different data terminals (column 3, line 66 through column 4, line 13, seen in Fig. 3, being the connection to the IP or e-mail address), and encoding/decoding functions (column 7, lines 40 through 53). However, Suzuki fails to teach if the information sets of communication capabilities of the different data terminals also include an image resolution, and a recording sheet size. Fite

Art Unit: 2622

discloses a client data terminal (fax machine 12, seen in Fig. 1, column 4, lines 26 through 49), comprising a first communications means that generates facsimile image information by reference to information of communication capabilities of a called data terminal (fax machines 24) to which the first communications means requests to send such facsimile image information and then performs a standard facsimile communications operation with respect to an information transfer request for requesting a transmission of the facsimile image information to an arbitrary facsimile machine connected to a public switched telephone network (column 11, lines 11 through 67), the called data terminal being one of a plurality of different data terminals coupled to the public switched telephone network (see Fig. 1), and a second communications means that performs at an arbitrary time the standard communications operation with at least one of the plurality of different data terminals to receive information sets of communication capabilities of the at least one of the plurality of different data terminals (column 5, line 3 through column 6, line 11). Fite further teaches that the information sets of communication capabilities of the different data terminals includes information identifying at least a connection for specifying one of the registered different data terminals, an image resolution, a recording sheet size, encoding/decoding functions (column 7, line 21 through column 8, line 34). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Fite's teachings in the system of Suzuki. Suzuki's system would easily be modified to include Fite's teachings, therein conforming to standards being well-known throughout the art.

Regarding *claim 16*, Suzuki discloses the terminal discussed above in claim 12, but fails to specifically teach if the second communications means can convert the information transfer request sent from the first communications means, using the encoding/decoding functions

Art Unit: 2622

registered in the memory means as the information of communication capabilities of the called data terminal, when an encoding function used by the first communications means for conversion of the information transfer request is lower grade than the registered encoding/decoding functions. Fite discloses a terminal (discussed above with respect to claim 15), further teaching that the second communications means can convert the information transfer request sent from the first communications means, using the encoding/decoding functions registered in the memory as the information of communication capabilities of the called data terminal, when an encoding function used by the first communications means for conversion of the information transfer request is lower grade than the registered encoding/decoding functions (column 7, lines 1 through 34, column 12, lines 32 through 44, and column 13, lines 20 through 34). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Fite's teachings in the system of Suzuki. Suzuki's system would easily be modified to include Fite's teachings, therein conforming to standards being well-known throughout the art.

Conclusion


14. This is a continuing examination of applicant's earlier Application No. 09/316,908. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.



Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrp



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